

Serial No. 09/700,863

REMARKS

In the Office Action, the Examiner reviewed claims 1-4, 6-26, 28-46, 48 and 50-56 of the above-identified US Patent Application, with the result that the abstract was objected to, claims 6 and 28 were objected to in view of informalities, and all of the claims were rejected. Specifically:

- (a) claims 23-26, 28-35, 42 and 44 were rejected under 35 USC §102 in view of WO 94/00980 to Howse (the Howse publication);
- (b) claims 1-4, 6-13, 20 and 22 were rejected under 35 USC §103 in view of the Howse publication and Applicants' admitted prior art (APA);
- (c) claims 14-19, 21, 36-41, 43, 45, 46, 48 and 50 were rejected under 35 USC §103 in view of the Howse publication and U.S. Patent No. 5,685,109 to Rimback;
- (d) claims 51-56 were rejected under 35 USC §103 in view of the Howse publication, the APA and Rimback;
- (e) claims 23 and 44 were rejected under the judicially-created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 6,041,543 to Howse (the Howse patent);
- (f) claims 1, 4, 6, 10, 11 and 22 were rejected under the judicially-created doctrine of obviousness-type double patenting over claim 21 of the Howse patent in

Serial No. 09/700,863

view of the APA;

(g) claim 3 was rejected under the judicially-created doctrine of obviousness-type double patenting over claims 21 and 22 of the Howse patent in view of the APA;

(h) claim 9 was rejected under the judicially-created doctrine of obviousness-type double patenting over claims 12, 19 and 20 of the Howse patent in view of the APA;

(i) claims 14-19 were rejected under the judicially-created doctrine of obviousness-type double patenting over claim 21 of the Howse patent in view of Rimback;

(j) claims 36-41, 43, 45, 46 and 50 were rejected under the judicially-created doctrine of obviousness-type double patenting over claim 1 in view of the Howse patent in view of Rimback; and

(k) claims 24, 28-30, 32-35 and 42 were rejected under the judicially-created doctrine of obviousness-type double patenting over claim 1 of the Howse patent in view of the Howse publication.

In response, Applicants have amended the specification and claims as set forth above.

More particularly:

The specification has been amended to correct a clerical error in the Abstract.

Dependent claims 6 and 28 have been amended to address the claim objection.

Serial No. 09/700,863

Dependent claims 11 and 33 have been amended to recite that the powder retains an electrostatic charge while on the surface, as opposed to being "capable of retaining" the electrostatic charge.

Independent method claim 1 has been amended to add the step of electrostatically coating at least part of the pest with the particulate material. Support for this amendment can be found in Applicants' as-filed claim 2 (now cancelled).

Independent claims 1, 23, 45 and 51 have been amended to recite that the particulate material is sufficiently fine as to become both airborne and electrostatically charged by movement of the pest in the region of the surface, as opposed to "being capable of being" electrostatically charged when rendered airborne. Support for these amendments can be found in Applicants' as-filed claims 2, 24, 48, 52 and 54 (now cancelled), as well as Applicants' specification at lines 15-23 of page 2, lines 3-15 of page 4, line 20 of page 7 - line 3 of page 8, etc.

Claims 3, 25 and 56 have been amended to depend from claims 1, 23 and 51 in view of the cancellation of their parent claims 2, 24 and 55, respectively.

Applicants believe that the above amendments do not present new matter. Favorable reconsideration and allowance of remaining claims 1, 3, 4, 6-23, 25, 26, 28-46, 50, 51, 53 and 56 are respectfully requested in view of the above amendments and the following remarks.

Serial No. 09/700,863

Objection to the Specification

As indicated above, an objection to the Abstract has been addressed by correcting a clerical matter. As such, Applicants respectfully request withdrawal of the objection to the specification.

Objection to the Claims

Claims 6 and 28 were objected to as depending from cancelled claims 5 and 27. As indicated above, this objection has been addressed by amending claims 6 and 27 to depend from their respective parent claims 1 and 23. As such, Applicants respectfully request withdrawal of the objection to the claims.

Rejection under 35 USC §102

Independent claim 23 and its remaining dependent claims 25-26, 28-35, 42 and 44 were rejected under 35 USC §102(b) as being anticipated the Howse publication. Applicants respectfully request reconsideration of this rejection in view of the following comments.

As an initial matter, the Howse publication is the priority document for the Howse patent, which was applied under seven obviousness-type double patenting

Serial No. 09/700,863

rejections as set forth above. For consistency, passages cited by Applicants from the Howse publication will be made in reference to the column and lines at which the passages are found in the Howse patent.

As noted in §2131 of the MPEP:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the ...claim. The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e. identity of terminology is not required. (Citations omitted).

Applicants' independent claim 23 requires a pest control apparatus comprising:

a surface (4,14) in a region of which a pest is capable of being lured and which bears a particulate material (7,17) incorporating a killing or behavior-modifying agent, the particulate material (7,17) being sufficiently fine as to become both airborne and electrostatically charged by the pest flying in the region of the surface (4,14).

As such, the particles are positively recited as becoming electrostatically charged when rendered airborne by a nearby flying insect, as opposed to being "capable of being electrostatically charged."³

³ At page 3 of the Office Action, the Examiner stated "Note that it has been held that the recitation that an element is 'capable of' performing a function is not a positive limitation but only

Serial No. 09/700,863

In contrast, the Howse publication does not disclose anywhere that the particles employed are sufficiently fine as to become airborne as a result of a pest flying in the region of a surface (19,43) on which the particles are present. Instead, the Howse publication is limited to particles that are electrostatically charged during deposition on the surface (19,43) so as to adhere to the surface (19,43) (see column 3, lines 1-3, column 4, lines 8-17, of the Howse patent), and which become electrostatically attached to a pest as a result of the pest contacting the particles when walking on the surface (19,43) (see column 3, lines 4-21, column 4, lines 18-23, of the Howse patent). Again, Applicants draw the Examiner's attention to the term "airborne," whose plain meaning is "borne in or by the air" (emphasis added). *Webster's New Twentieth Century Dictionary, Unabridged*, Second Edition (1977). Accordingly, Applicants' claimed airborne particles are borne in or by the air before contacting the pest.

In view of the above, Applicants believe that the Howse publication does not anticipate independent claim 23 nor any of its dependent claims under the test for anticipation set forth at MPEP §2131, and therefore respectfully requests withdrawal of the rejection under 35 USC §102.

requires the ability to so perform. It does not constitute a limitation in any patentable sense." This statement is incorrect because it is completely contrary to MPEP 2173.05(g), which clearly sets forth that functional limitations stating that an element of a claim is "capable of" something is permissible if it fulfills the obligations of 35 USC §112, second paragraph.

Serial No. 09/700,863

Rejections under 35 USC §103 and Obviousness-type Double Patenting

Each of the rejections under 35 USC §103 and under obviousness-type double patenting is based on either the Howse publication or claims of the Howse patent (with or without a secondary or tertiary reference). As previously noted, the Howse publication is the priority document for the Howse patent. Obviousness-type doubling patenting rejections are to be analyzed in the same manner as rejections under 35 USC §103.⁴ As such, the following arguments summarize the teachings of the Howse publication and patent together.

The rejections under 35 USC §103 and under obviousness-type double patenting were on the basis that the Howse publication and the claims of the Howse patent, respectively, teach the use of a particulate material incorporating a killing or behavior-modifying agent, and drawing a pest to a surface bearing the particulate material. At page 5 of the Office Action, the Examiner stated that, from the Howse

⁴ MPEP §804 II.B.1., states that:

Since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), . . . are employed when making an obvious-type double patenting analysis.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, *the disclosure of the patent may not be used as prior art.* (Emphasis added).

Serial No. 09/700,863

publication

it is therefore understood that the friction of movement in the air can charge the particles, but Howse does not specifically discuss that movement of a pest in the region of the surface renders the particulate material airborne.

The Examiner then relied on the APA for teaching that

a flying insect provides downward momentum to the air around it and can generate vortices on the downward strokes of their wings. This teaching therefore demonstrates that the movement of an insect's wings is naturally accompanied by movement of the air around the insect. (Citation omitted.)

From this, the Examiner concluded that

it is considered inherent in the method disclosed by Howse that the fine particles in the Howse trap would be rendered airborne when a flying insect was drawn close to the surface with the particulate material. This is a naturally occurring phenomenon. As discussed above, Howse teaches that friction imparts a charge to the particles, and it is therefore understood that movement of the particles into the air would provide them with a charge.

Applicants take issue with the above analysis for two reasons. First, the Examiner concluded without any basis that the particles disclosed in the Howse publication are sufficiently fine as to become airborne by the mere wing action of a flying insect. If the

Serial No. 09/700,863

Examiner is to maintain that Howse' particles are sufficiently small for this to occur, Applicants must respectfully require the Examiner to cite a passage from the Howse publication that supports this assertion.

Secondly, the conclusions drawn to form the rejections lack any basis for fulfilling the requirements set forth in *In re Vaeck*, 20 USPQ2D 1438, 1442 (Fed. Cir. 1991), which restated the criteria for obviousness as follows:

Where claimed subject matter has been rejected as obvious in view of a combination of prior art references, a proper analysis under §103 requires, *inter alia*, consideration of two factors: (1) whether the prior art would have *suggested* to those of ordinary skill in the art that they *should make* the claimed composition or device, or carry out the claimed process; and (2) whether the prior art would also have a *reasonable expectation of success* *Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.*
(Emphasis supplied).

See MPEP §§2142 and 2143.02.

Therefore, there must be something within the Howse publication, the claims of the Howse patent, or one of the other references that would suggest Applicants' claimed invention to one skilled in the art. However, as previously noted, the Howse publication and patent completely lack any suggestion to use powders that are so fine as to become airborne when a flying insect passes nearby, and none of the other applied references

Serial No. 09/700,863

make up for the lack of such teachings. Furthermore, in order for the Howse publication or patent to be combinable with the applied secondary and tertiary references to formulate a §103 or obviousness-type double patenting rejection, the prior art must provide some basis for a reasonable expectation of success. However, in the present case, the only basis for expecting success - i.e., the ability to both render a particulate material airborne and electrostatically charged by the mere proximity of a flying pest - is derived solely from Applicants' teachings, and not the cited prior art. In other words, the mere fact that "the movement of an insect's wings is naturally accompanied by movement of the air around the insect" and "friction imparts a charge to the particles" does not provide any reasonable expectation that the movement of an insect's wings would be sufficient to render a particulate matter airborne, and that such movement of the particles would be sufficient to "provide them with a charge." It is purely speculative from the teachings of the Howse publication and patent as to whether these fundamental and claimed aspects of Applicants' invention would occur.

For all of the above reasons, Applicants respectfully request withdrawal of the 35 USC §103 rejections and the judicially-created double patenting rejections of Applicants' claims based on the Howse publication and patent.

Serial No. 09/700,863

Closing

In view of the above, Applicants believe that their claims define patentable novelty over all the references, alone or in combination, of record. It is therefore respectfully requested that this patent application be given favorable reconsideration.

Should the Examiner have any questions with respect to any matter now of record, Applicants' representative may be reached at (219) 462-4999.

Respectfully submitted,

By Gary M. Hartman
Gary M. Hartman
Reg. No. 33,898

July 28, 2003
Hartman & Hartman, P.C.
Valparaiso, Indiana 46383
TEL.: (219) 462-4999
FAX: (219) 464-1166